

### **REMARKS**

Claims 1, 6-8 and 28-30 remain pending in the present application. Claim 1 has been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1, 6, 7 and 28-30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 has been amended to overcome the rejection. Reconsideration of the rejection is respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1 and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reichert (U.S. Pat. No. 4,582,304) in view of Ayyildiz, et al. (U.S. Pat. No. 6,109,400). Applicants respectfully traverse this rejection.

The Examiner's position is that Reichert discloses most of the elements defined in pending Claim 1, but that Reichart fails to disclose that the valve body is fixedly secured to the inner cylindrical surface of the pressure tube and a continuously open flow path extending through the body. The Examiner then looks to Ayyildiz, et al. to show a valve body 7 fixedly secured to the inner cylindrical surface of the pressure tube and a continuously open flow path extending through the valve body. The Examiner then states that it would be obvious to combine these references in order to achieve the required damping.

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were *prima facie* obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified

gasoline, and the screen would become clogged.)

Reichart is directed toward a gas spring with pressure loss safety. As stated in Column 1 beginning at line 51 of Reichart, the object of the invention, therefore, is to provide a gas spring with a collapse safety of simple structure and high dependability. This object is accomplished, according to the invention, in that a movable partition is arranged between the piston and the head of the cylinder, and is exposed to gas chambers under pressure on both sides. When the pressures in the chambers are equal or approximately so, the extension force of the spring is the pressure prevailing in the zone of the piston rod times the piston rod area. If the pressure in the gas chamber parted by the piston is lowered because of a leak, the partition will move towards the piston until pressure equalization is restored. Upon retraction of the piston rod into the cylinder, the piston will thus come into contact with the partition, so that upon further retraction of the piston rod the extension force is increased sharply by the additional support of the partition. In this way, a very simple collapse safety is provided with a single part, and a high dependability of the gas spring is assured.

If the fixed piston of Ayyildiz, et al. is combined with Reichart, the pressure loss safety feature, which is the object of Reichart, is destroyed. Reichart requires that the partition moves to equalize the pressure after a pressure loss. The movable partition is the safety stop which provides additional support for the piston and piston rod eliminating the rapid collapse of the gas spring. Therefore, there is no motivation to replace the movable partition of Reichart with the fixed valve body of Ayyildiz, et al.

Thus, Applicants believe Claim 1 patentably distinguishes over the art of record. Likewise, Claim 28, which depends from Claim 1, is also believed to patentably

distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

Claims 6, 7, 29 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Reichert in view of Ayyildiz, et al. as applied to Claim 1 above, and further in view of Furuya, et al. (U.S. Pat. No. 5,042,624). Claims 6, 7, 29 and 30 ultimately depend from Claim 1. As detailed above, Claim 1 is believed to patentably distinguish over the art of record. Thus, Claims 6, 7, 29 and 30 are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

#### **REJOINDER**

Applicants respectfully request the rejoinder of Claim 8.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: January 13, 2005

By: 

Michael J. Schmidt, 34,007

HARNESS, DICKEY & PIERCE, P.L.C.  
P.O. Box 828  
Bloomfield Hills, Michigan 48303  
(248) 641-1600

MJS/pmg